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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,447	05/25/1999	PERI HARTMAN	24976.8002.1	1430

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/318,447

Applicant(s)

HARTMAN ET AL.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6, 7. 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings filed on 9/29/99 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-20 are rejected under the judicially created doctrine of double patenting over the claims and specification of U. S. Patent No. 5,960,411 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

4. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A method and system for placing a purchase order via a communications network.

Information Disclosure Statement

5. Concerning IDS dated May 25, 1999, the US patents have been reviewed, however the Other prior art publications and Foreign documents were not considered because copies were not available at the time of this office action.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-8, 16-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Blinn et al. (US 6,058,373).

8. In regards to claim 1, Blinn discloses a method for placing an order to purchase an item, the order being placed by a purchaser at a client system and

received by a server system (**FIG 1**), the method comprising: under control of the server system, receiving purchaser information including identification of the purchaser (**FIG 3, item 368**), payment information (**FIG 3, Item 368**), and shipment information from the client system (**FIG 3, Item 378**); assigning a client identifier to the client system (col. 15, lines 55-67); associating the assigned client identifier with the received purchaser information (col. 15, lines 55-67); sending to the client system the assigned client identifier (col. 15, lines 55-67); and sending to the client system display information identifying the item and including an order button (col. 13, lines 25-30); under control of the client system, receiving and storing the assigned client identifier (**FIG 3 and 7, Item 300**); receiving and displaying the display information (**FIG 4,5,6**); and in response to the selection of the order button, sending to the server system a request to purchase the identified item (col. 20, lines 25-67 and col. 21, lines 1-51), the request including the assigned identifier (**FIG 9, Shopper Identifier**) ; and under control of the server system, receiving the request; and combining the purchaser information associated with the client identifier included with the request to generate an order to purchase the item in accordance with the billing and shipment information whereby the purchaser effects the ordering of the product by selection of the order button (**FIG's 12,12A,12B, and 12C**).

9. In regards to claim 2, Blinn teaches wherein the purchaser information is received when the purchaser placed a previous order (**Shopper Table FIG 3 and 7**).

10. In regards to claim 3, Blinn discloses a method for ordering an item using a client system (**FIG 1**), the method comprising: providing an identifier that identifies a customer; displaying, information identifying the item and displaying an indication of an

action that is to be performed to order the identified item (**FIG 6, "Purchase Now"** button); and in response to the indicated action being performed, sending to a server system the provided identifier and a request to order the identified item whereby the server system uses the sent identifier to identify additional information needed to generate an order for the item (see response to claim 1).

In regards to claim 4, Blinn teaches wherein the identifier identifies the client system and the server system provides the identifier to the client system (col. 15, lines 55-67).

11. In regards to claim 5, Blinn teaches wherein the client system and server system communicate via the Internet (**FIG 1**).

12. In regards to claim 6, Blinn teaches wherein the identifier is provided by the server system (**FIG 3, Item 300**).

13. In regards to claim 7, Blinn teaches wherein the displaying includes displaying an HTML document provided by the server system (**FIG 1, Item 128**).

14. In regards to claim 8, Blinn teaches sending from the client system to the server system a confirmation that the order was generated (**FIG 5, item 414**).

15. In regards to claim 16, Blinn teaches wherein the displaying includes displaying partial information supplied by the server system as to the identity of the user (**FIG 6, See display of credit card information e.g. "Gary's Card"**).

In regards to claim 17, Blinn teaches wherein the displaying includes displaying partial shipping information supplied by the server system (**FIG 5, See "Ship to" and "Edit addresses"**).

16. In regards to claim 18, Blinn teaches wherein the displaying: includes displaying partial payment information supplied by the server system (see response to claim 16 above).

16. In regards to claim 20, Blinn teaches when the displaying includes displaying a moniker identifying a shipping address for the customer (**FIG 5**, See "Gary's House" on pull down menu).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 9-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn, and further in view of Trommer.

19. In regards to claims 9-15 and 19, Blinn teaches a method of conducting electronic commerce over the Internet where a display indication or "button" can be activated to purchase an item, but does not specifically mention a single action to enable the process. Trommer teaches a method that allows "one click commerce" (Para. 11). It would be obvious to a person of ordinary skill in the art to include in Blinn the single action as taught by Trommer, because having to click the object once simplifies the process. Please note that it is old and well known in the art that different methods of activating a display indication were available and could have been used in Blinn to activate an action by clicking a mouse, voice activation, a television remote, key on a key pad, pointing device, or a button. Blinn would be motivated to include these

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methods of activation, because the method presented in Blinn would be used on devices that don't have a mouse and would require this alternative method of activation.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Fadok whose telephone number is (703) 605-4252. The examiner can normally be reached on Monday to Friday 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Mark Fadok
March 8, 2002



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